



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Assistant Secretary and Commissioner of
Patents and Trademarks
Washington, D.C. 20231

#70

FEB 8 1999

MAILED:

Paper No. 70

In re application of : J. Bednorz et al.
Serial Number: 08/303561 :
Filed: September 09, 1994 : DECISION ON PETITION
: UNDER 37 C.F.R. 1.181

For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION
TEMPERATURE, AND METHODS FOR THEIR USE AND PREPARATION

This is a decision on the Petition for Withdrawal of the Final Rejection, filed December 3, 1998 seeking to withdraw the finality of the Office Action of June 25, 1998. This petition is appropriate under 37 CFR 1.181. The Petitioner asserts that the finality is improper and requests a new non-final action. The Petitioner states that: "Applicants are entitled to know why the examiner has maintained the rejection under 35 USC 102 and 103 over the Asahi Shinbum article in light of applicants proof which the examiner has not rebutted. Applicants are in the position of having to guess at what are the reasons for maintaining these rejections. Applicants cannot properly appeal these rejections with out knowing the examiner's reasons for maintaining the rejections."

BACKGROUND

Claims 24-26, 86-90, 96-135, and 137-142 have been rejected under 35 USC 102(a) as anticipated by the Asahi Shinbum article and have been rejected under 35 USC 103 as being unpatentable over the Asahi Shinbum article. According to the Petitioner, the applicants have proven (see Substitute Amendment, Paper 59, pages 22, line 8 to page 24, last line, filed March 6, 1997) that their invention was reduced to practice in the United States prior to the date of the Asahi Shinbum article. Further it is alleged that the examiner has not rebutted applicants' proof that applicants' conception was in the United States at their direction prior to the date of the Asahi Shinbum article and the examiner has not denied that applicants have proven that they were diligent by instructing coworkers in the United States from a time prior to the date of the Asahi Shinbum article until the date the examiner believes is the date of applicants' date of reduction to practice in the United States. The Petitioner takes specific issue with the examiner's response to applicants' proof (found in the above cited portion of Paper 59) at page 19, paragraph d, ii of the final rejection which concludes that: "Nevertheless, the actual reduction in this country is deemed to have occurred on December

3,1986, which is after the publication date for the reference". Again, the Petitioner urges that the final rejection should be withdrawn and requests a new non-final action containing the reason why the examiner disagrees with the applicants' proof of conception, diligence and reduction to practice in the United States prior to the date of the Asahi Shinbum article.

DECISION

A careful review of the application record indicates that the Petitioner's request to withdraw the finality of the June 25, 1998 office action should be denied. In the final office action mailed June 25, 1998, pages 16 through 20, the examiner has specifically and clearly addressed applicants' arguments regarding the 35 USC 102(a) rejection over the Asahi Shinbum article and proof of reduction to practice in this country as set forth in applicants Paper No. 59, filed March 6, 1997. The examiner on page 19, section d)I clearly asserts that the applicants were unable to show the attainment of superconductivity any earlier than December 3, 1986 in this country. The examiners' reason for his conclusion is: "Again, the present invention is directed to the method of superconducting electricity. That **method** (emphasis added) apparently was not reduced to practice before December 3, 1986". Thus, the final office action has in fact provided the reasons why applicants proof of an earlier reduction to practice in this country was not acceptable to the examiner. The final office action of record is considered to be proper and will not be withdrawn as Petitioner has requested.

Receipt is acknowledged for the AMENDMENT AFTER FINAL REJECTION UNDER 37 CFR 1.116 and the 37 CFR 1.132 AFFIDAVIT OF Dr. James W. Leonard filed on December 15, 1998. Both of these documents will be forwarded to the examiner of record for consideration.

The petition is **denied**.



Richard V. Fisher
Director Group 1700
Specialized Chemical Industries
and Chemical Engineering

Daniel P. Morris
IBM CORPORATION
Intellectual Property Law Dept.
P.O. Box 218
Yorktown Heights, New York 10598